

REMARKS

By this amendment, claims 1-40 are pending, in which claims 1, 2, 20, 21 and 38 are currently amended, and claim 40 is newly presented. No new matter is introduced.

The Office Action mailed June 7, 2004 rejected claims 1, 5, 7, 8, 11, 13, 17-21, 25, 27, 28, 31, 33, 37 and 38 under 35 U.S.C. § 102 as anticipated by *Hendel et al.* (US 5,920,566), claims 6, 9, 10, 12, 16, 26, 29, 30, 32, 36 and 39 as obvious under 35 U.S.C. § 103 based on *Hendel et al.*, and claims 2-4, 14, 15, 22-24, 34 and 35 as obvious under 35 U.S.C. § 103 based on *Hendel et al.* in view of *Nessett et al.* (US 5,968,176). Also, claims 1-39 were rejected under 35 U.S.C. § 112, second paragraph.

Applicants have amended the Specification with respect to the noted informalities according to the Examiner's helpful suggestions.

In view of the amendment, Applicants believe the § 112, second paragraph rejection for indefiniteness is overcome. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually satisfactory claim language.

To advance prosecution, independent claims 1, 20 and 21 have been amended. Independent claim 1 now recites "**an external processor configured** to invoke a policy-based service on received messages according to a policy rule and **to establish a network connection between a first network and a second network.**" Claim 20, as amended, recites "**an external processor configured** to invoke a policy-based service on received messages according to a policy rule by reference to the policy decision point and **to establish a network connection between a first network and a second network.**" Amended independent claim 21 recites "passing identified messages to **an external processor configured** to enforce the policy rule and **to setup a connection with the first network.**"

By contrast, *Hendel et al.* discloses a multi-layer distributed network element (MLDNE) for relaying packets according to known routing protocols. The MLDNE has a number of subsystems that are coupled by internal links. (col. 4:53-59) When a packet is received by a first “inbound” subsystem, the subsystem determines whether the packet should be routed based upon a first header portion, including a Layer 2 destination address of the received packet, matching a Layer 2 address of the MLDNE. If the first header portion of the received packet matches the MLDNE address, then the first subsystem determines, using its forwarding memory, whether a route has been previously determined for a second header portion, including Layer 3 source and destination addresses, of the received packet. Additionally, *Hendel et al.* discloses (col. 7: 30-45) that the MLDNE 201 includes a central processing system (CPS) 260 that is coupled to the individual subsystems 210 through a communication bus 251 such as the Peripheral Components Interconnect (PCI). The CPS has a direct control and communication interface to each subsystem 210. The CPS is also configured with a number of routing protocols that are used to identify a neighbor node as part of a route for forwarding a received packet to its ultimate destination, normally specified in the Layer 3 destination address of the packet. Other responsibilities of the CPS 260 include setting data path resources such as packet buffers between the different subsystems.

The system in *Hendel et al.*, does not provide any capability for the CPS to establish or setup a network connection, in the manner claimed.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a prior art reference, based on the foregoing, it is clear that *Hendel et al.* fails to teach the features of independent claims 1, 20 and 21, as amended. Thus, Applicants respectfully request withdrawal of the rejection under § 102.

With respect to obviousness rejection of claims 6, 9, 10, 12, 16, 26, 29, 30, 32, 36 and 39, the Examiner relies entirely on the convenience of Official Notice in view of *Hendel et al.* This summary rejection based on the Examiner's knowledge is contrary to settled law. The Administrative Procedure Act requires the Patent Office to articulate and place on the record the "common knowledge" used to negate patentability. *In re Sang Su Lee*, No. 00-1158 (Fed. Cir., Jan. 18, 2002); *In re Zurko*, No. 96-1285 (Fed. Cir., Aug. 2, 2001). The notable features under Official Notice (page 6 and 7 of the Office Action) include "using primary and secondary controllers to utilize the secondary controller if the primary fails is well known and expected in the art" and "using NMS server with billing facility coupled to the external processor is well known and expected in the art"; such taking of Official Notice falls short of this requirement. Furthermore, although the Examiner may in some instances take official notice of certain facts to fill in the gaps, such facts should not comprise the principle evidence upon which a rejection is based. See *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970).

Further, pursuant to the MPEP § 2144.03, Applicants respectfully traverse the Official Notice and request the Examiner to produce references showing the claim features or withdraw the rejection as factually inadequate.

As regard the obviousness rejection of claims 2-4, 14, 15, 22-24, 34 and 35, the addition of *Newsett et al.* does not cure the deficiencies of *Hendel et al.* The secondary reference of *Newsett et al.* is applied for the supposed teachings of plurality of policy servers and caching selective policies (Office Action, page 8). The *Newsett et al.* is directed to establishing and enforcing security functions in a network; and more particularly to systems for establishing security functions in a plurality of protocol layers to establish a multilayer firewall in a network. (co. 1: 5-10). Accordingly, Applicants respectfully request withdrawal of the obviousness rejection.

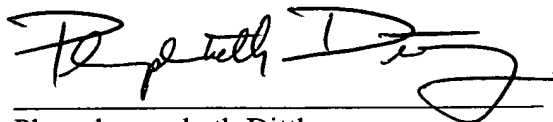
Turning now to new claim 40, this independent claim is drawn to a system for providing distributed control of communication services, and recites **“an external processing module configured to provide signaling for establishment and teardown of a connection between a first network and a second network**, the external processing module being further configured to apply a policy rule on traffic flow from the first network over the connection.” As pointed above, the applied art is devoid of these features. Accordingly, new claim 40 is allowable.

Therefore, the present application, as amended, overcomes the objections and rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-8508 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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9/7/04
Date



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